

REMARKS

Claims 1-9, 11-15, and new claims 16-18 appear in this application for the Examiner's review and consideration. Applicants would like to thank the Examiner for the phone interview of July 16, 2003 with the Applicants' agent, William B. Lacy, in which the Examiner confirmed that claim 10 would be allowable if re-written in independent form. As such, claim 1 has been amended to recite the subject matter of claim 10. Claim 9 has been amended to depend from claim 2. Claim 10 has been cancelled. Claim 13 has been amended to correct a typographical error. New claims 16-18 have been added. The Specification on page 3, lines 17-26 has been amended to correct two typographical errors. No new matter has been added by these amendments and additions.

Rejection Under 35 U.S.C. § 112, First Paragraph

Claim 13 was rejected under 35 U.S.C. § 112, first paragraph. Applicants respectfully note that U.S. patent laws and regulations do not require compounds as disclosed in an application to have CAS registry numbers. The CAS registry is a listing of many compounds, but is by no means an all-inclusive list of existing compounds. Absence of such a number is irrelevant to the existence of a compound or its patentability. Moreover, it is commonplace in the CAS registry for starting materials to have CAS numbers, but their reaction product does not.

Additionally, one of ordinary skill in the art would be aware of several means to derive the compounds of claim 13. For example, the compounds of claim 13 can be generated from the compounds of claim 2 via an amination reaction, in which the hydroxyl groups are replaced by amine groups.

For at least the above reasons, the rejection under 35 U.S.C. § 112, first paragraph, is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Objection Under 37 C.F.R. § 1.75(c)

Claim 13 was objected to under 37 C.F.R. § 1.75(c). Claim 13 has been amended to depend from claim 11. As such, the objection under 37 C.F.R. § 1.75(c) is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 9 was rejected under 35 U.S.C. § 112, second paragraph. Claim 9 has been amended to depend from claim 2, which does provide antecedent basis for "diol curing agent." As such, the rejection under 35 U.S.C. § 112, second paragraph is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

Rejection Over U.S. Patent No. 3,937,474

Claims 1, 5, 7, 8, 11, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,937,474 to Jepson *et al.* ("Jepson"). To facilitate the prosecution of the present invention, claim 1 has been amended to recite the element of claim 10, which the Examiner indicated would be allowable if re-written in independent form. Accordingly, independent claim 1 is believed to be in condition for allowance for at least the reason set forth above. Moreover, the remaining claims 5, 7, 8, 11, and 12 are believed to be patentable for the totality of the claimed inventions therein and by virtue of their dependence from the independent claim. As such, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Rejection Over U.S. Patent No. 4,326,716

Claims 1-5, 7, 8, 11, and 12 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,326,716 to LaCoste ("LaCoste"). LaCoste is directed to one-piece, wood-type, molded golf club head made entirely or predominantly of a polyurethane vulcanizate.

Applicants respectfully submit that the Examiner's assessment as stated on page 3 of the Office Action, that "LaCoste discloses a built in insert striking surface," is erroneous. According to Webster's Dictionary (Revised Edition, 1996, Houghton Mifflin Company), the word "insert," when used as a noun, means "something inserted or to be inserted." That is, the insert is to be put or introduced into the body of something else. In fact, LaCoste specifically defines an insert as "... a plate ... fitted into a recessed portion ... in the center of the face of [a golf club]" (see column 1, lines 51-54). Furthermore, LaCoste clearly states in column 3, lines 38-41, that the claimed invention of LaCoste differs materially from the teaching of Jepson. LaCoste teaches one-piece, solid, molded club heads made of a urethane polymer; there is no insert of any sort.

However, in order to facilitate the prosecution of the present invention, claim 1 has been amended to recite the element of claim 10, which the Examiner indicated would be allowable if re-written in independent form. As such, independent claim 1 is believed to be in condition for allowance. Claims 2-5, 7, 8, 11, and 12 are believed to be patentable at least by virtue of their dependence from the independent claim 1. For at least these reasons, Applicants respectfully request that the rejection under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Rejection Over Jepson In View of U.S. Patent No. 5,994,466 and Publication of Woods

Claims 6, 14, and 15 were rejected under 35 U.S.C. § 103(a) as being obvious over Jepson in view of U.S. Patent No. 5,994,466 to Yang ("Yang") and publication of Woods ("Woods"). As amended, claim 1 is believed to be in condition for allowance because it now recites the subject matter of claim 10, which the Examiner indicated would be allowable if re-written in independent form. Therefore, at least by virtue of their dependence from claim 1, claims 6, 14, and 15 are also believed to be in condition for allowance. As such, the rejection under 35 U.S.C. § 103(a) is believed to have been overcome. Applicants respectfully request reconsideration and withdrawal thereof.

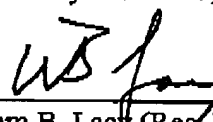
Conclusion

Based on the remarks set forth above, Applicants believe that all of the rejections and objections have been overcome, and the pending claims of the subject application are in condition for allowance. Should the Examiner have any further concerns or believe that a discussion with the Applicants' agent would further the prosecution of this application, the Examiner is encouraged to call the agent at the number below.

With this submission, the application now have 3 independent claims and 14 dependent claims. As such, no fee is believed to be due for this submission. However, should any other required fees be due, please charge them to the Acushnet Company Deposit Account No. 502309.

7.16.03
Date

Respectfully submitted,



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